

No. 12323

IN THE
United States Court of Appeals
FOR THE NINTH CIRCUIT

EARL A. ERNST,

Appellant,

vs.

A. G. CLEMENS, and H. G. McBRIDE, and A. G. CLEMENS,
and H. G. McBRIDE, doing business as IDEAL MANU-
FACTURING COMPANY,

Appellees.

BRIEF FOR APPELLEES.

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Appellees.

BRIEF FOR APPELLEES.

Jurisdiction of This Court.

The statement as to jurisdiction appearing in Appellant's Opening Brief we concede to be correct.

Statement of the Case.

CHRONOLOGY.

We do not find it feasible to correct inaccuracies or omissions in the discussion of the "inventions in suit" contained in Appellant's Opening Brief (pp. 3-14), and for that reason and to preserve a continuity we present the following chronology which is supported generally by

the uncontroverted testimony of J. Walker Glenn, the testimony of Spencer Darby Day, and in several instances, by the testimony of Plaintiff-Appellant's expert witness, Harry Gearing.

Prior to 1913, it was the conventional procedure for farmers to dig their potatoes, select and grade them in the field as dug, and to deposit the potatoes into "large mug" sacks by hand. [Tr. 117.] This process was largely manual and necessarily so because it was the practice to arrange specimen potatoes on the top of the sacks for display purposes. This was known as facing. [Tr. 120.]

The advent of mechanical aids to handle potatoes between 1913 and 1915 somewhat altered the potato harvesting, sorting, grading and sacking procedure. [Tr. 118.] At about this time, it became the practice to haul potatoes from the field and to deposit them on a table for sorting and grading purposes preliminary to sacking. The first tables were merely slanted boxes down which the potatoes gravitated and were manually urged. Later, a shaker box was employed which was rocked backward and forward to jiggle or vibrate the potatoes as a sorting and grading convenience. The shaker boxes were generally of the form shown at 72 in Fig. 1 of the Bradbury Grain Separator patent, No. 826,988 [Tr. Vol. II, p. 356], according to the testimony of J. Walker Glenn, but were originally hand motivated. [Tr. 118-119.]

In 1928 it became popular to employ hand jiggled sack holders adapted to receive sacks suspended thereon into which potatoes were directed. [Tr. 119.] As early as 1933, the potatoes were conveyed by means of a belt conveyor and diverted from the belt into sacks by a movable shearer. [Tr. 119.] At this time, it was not regarded as practical mechanically to jiggle the sacks because of the

continuing requirement that the “open mug” sacks, which were generally demanded by the trade, be faced for display purposes. [Tr. 120.]

Subsequently, the trade gradually accepted larger sacks having somewhat constricted tops and the facing required for “open mug” sacks was gradually abandoned. The abandonment of the “open mug” sacks made possible the mechanical jiggling of the sacks for the settling of potatoes therein and several manufacturers, including the plaintiff, defendants, and several others, produced and sold machines for that purpose. It was a simple step to substitute a power drive for the manual manipulation of the sack holder previously employed. [Tr. 120 *et seq.*]

In 1946 under a license arrangement entered into with a man by the name of Biloff, one or more of the defendants started manufacturing and selling a sacking machine employing a conveyor belt, a shear plate adapted to divert articles from the belt, means for holding sacks to receive articles diverted by the shear plate, and a jiggle board on which the sacks were rested and vibrated to settle the articles therein. [Tr. 106 *et seq.*] During the production and sale of the Biloff apparatus, the defendants made certain modifications and improvements therein and met with a measure of commercial success, as did nearly all manufacturers of potato sacking equipment after the need for facing the “open mugs” ceased. Unable to obtain a patent in this art, Biloff subsequently notified the defendants then building the Biloff apparatus that they need no longer pay him royalty thereon.

On April 29, 1948, the plaintiff-appellant filed this suit against the defendants alleging infringement of Claim 1 of United States Letters Patent No. 2,288,159, issued in the name of Frederick J. Ernst, to plaintiff-appellant Earl

A. Ernst, administrator of said Frederick J. Ernst, on June 30, 1941 [Tr. 323], and Claim 1 of Patent No. Re. 22,740 [Tr. 326], issued to the plaintiff-appellant, Earl E. Ernst, on April 2, 1946.

The defendants-appellees' machines charged to infringe are illustrated in photographs, Plaintiff's Exhibits 11-A, 11-B, 11-C, 12-A, 12-B, and 16, and Defendants' Exhibits A, B, C, D and E. These photographs are physical exhibits not reproduced in the bound transcript.

TRIAL COURT'S DECISION.

As a result of the trial thus initiated, the Honorable Leon R. Yankwich rendered a decision March 12, 1949, holding that Claim 1 of each Patent was valid but not infringed by the defendants. [Tr. 17 *et seq.*] In his decision, Judge Yankwich commented [Tr. 18-19]:

"In a situation like the present one, we are in between a veritable Scylla and Charybdis. If we interpret the claims as they stand, there is no infringement. If, on the other hand, by resort to the specifications, we interpret them broadly and carry into the claims the elements which are not in them, we land the device in the prior art, and there is no invention."

Findings of Fact and Conclusions of Law were made [Tr. 21 *et seq.*], and a Final Judgment dismissing the Complaint was entered March 28, 1949. [Tr. 33-34.]

From such judgment the plaintiff has appealed to this Honorable Court, urging in his Opening Brief that Claims 1 of both of the Patents in suit are entitled to have the doctrine of equivalents invoked to such extent as to cause the claims to read on the defendant's apparatus.

Issues.

Broadly stated, the issues in the instant appeal are:

- A. Is the decision of the Trial Court that the defendants-appellees' structure does not infringe Claim 1 of Patent No. 2,288,159 so clearly erroneous as to warrant reversal of the judgment?
- B. Is the decision of the Trial Court that the defendants-appellees' structure does not infringe Claim 1 of Patent No. Re. 22,740, so clearly erroneous as to warrant reversal of the judgment.

Each of these primary issues involves consideration of a subordinate but nevertheless controlling issue which may simply be stated:

- C. Should the Trial Court have invoked the doctrine of equivalents in interpreting Claims 1 of either or both patents in suit to such an extent as to cause the same to read on the defendants-appellees' apparatus?

SUMMARY OF ARGUMENT.

I.

The Question of Infringement Is a Question of Fact and the Findings of the Court Below Should Not Be Disturbed Unless Clearly Erroneous.

II.

The Findings of the Court Below on the Issues of Infringement Are Fully Supported by the Evidence and Should Be Sustained.

A. Claim 1 of Patent No. 2,288,159 is not infringed by the defendants.

1. The scope of Claim 1 should not be enlarged.

a The Ernst conveyor belt unloading device was at most a very minor contribution to a crowded and well developed field of endeavor.

b. Diligent effort in behalf of F. J. Ernst was made to obtain broad protection but the Patent Office restricted the claims to narrow and specific terminology.

c. The precise point of novelty, if novelty is present in the structure defined by Claim 1, must of necessity reside in the precise combination set forth including, "*a loose sleeve on each bar having attached coupling means to hold a plate,*" and "*a plate having a portion of its ends in the coupling means.*"

2. The precise structure claimed is not even alleged to be found in any of the defendants' apparatus.

3. The interpretation of the patent required for its validity precludes infringement thereof by the defendants.

B. Claim 1 of Reissue Patent No. Re. 22,740 is not infringed by the defendants.

1. Ernst is not entitled to have the scope of Claim 1 enlarged.

a. If the Ernst device made any contribution to the crowded and thoroughly developed art of shaking devices to which it relates, such contribution is so minor as to be almost undetectable.

b. During the prosecution of the original application, the prosecution of the reissue application, and the appeal in the Patent Office the plaintiff made diligent effort to obtain broad protection, but the Patent Office examiner and Board of Appeals felt compelled to limit the claims to the specific language employed because of the prior art.

c. If Claim 1 relates to any novel structure, it must of necessity reside in the combination of an elongated platform having "*a central open locus*" and a vibratory means including a "*pitman*" "having its connection with the platform *at its central locus.*"

(1) The plaintiff's own expert acknowledged the existence of both central open *locii* in platforms, and pitman connected to platforms in devices of the prior art.

(2) Obviously the combination of these precise limitations are required to impart patentable novelty to Claim 1 of Re. 22,740.

2. The combination claimed is not found in any of the plaintiff's apparatus.

3. The patent having been interpreted so as to be valid, cannot be infringed by the defendants' apparatus.

ARGUMENT.

I.

The Question of Infringement Is a Question of Fact and the Findings of the Court Below Should Not Be Disturbed Unless Clearly Erroneous.

Graver Tank & Manufacturing Company, Inc., et al. v. The Linde Air Products Company, 336 U. S. 271, 93 L. Ed. Adv. Op. 492, 337 U. S. 910; *Stilz v. United States*, 269 U. S. 147, 70 L. Ed. 203;

Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U. S. 405, 52 L. Ed. 1122, 28 S. Ct. 748;

Keyes et al. v. Grant et al., 118 U. S. 25, 30 L. Ed. 57;

Thomson Spot Welder Company v. Ford Motor Company, 265 U. S. 446, 68 L. Ed. 1100;

Corona Cord Tire Co. v. Dovan Chemical Corp., 276 U. S. 375, 72 L. Ed. 616;

Faulkner v. Gibbs, 170 F. 2d 34, 79 U. S. P. Q. 158 (9 Cir.) (affirmed without reference to this point, 94 L. Ed. Adv. Op. 30, 83 U. S. P. Q. 192).

Rule 52a of the Federal Rules of Civil Procedure provides:

“Findings of Fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the Trial Court to judge of the credibility of the witness.”

In *Graver Tank & Manufacturing Company, Inc., et al. v. The Linde Air Products Company*, *supra*, 336 U. S. 271, 93 L. Ed. Adv. Op. 492, 337 U. S. 910, the latest

decision of the Supreme Court of the United States which we have been able to find relative to this point, Mr. Justice Jackson expressed the opinion of seven members of the Court as follows:

“The rule requires that an Appellate Court make allowance for the advantages possessed by the Trial Court in appraising the significance of conflicting testimony and reverses only ‘clearly erroneous’ findings.”

A rehearing was granted by the Supreme Court in this matter but on another question. Justice Black and Douglas dissented from this opinion urging that the patentability of an invention is a question of law to be decided by the Courts as such. The issue in the instant matter does not involve the question of patentability but rather that of infringement. At any rate, Justice Jackson’s words are believed to be a sound statement of the law.

The Supreme Court of the United States in an appeal from the Court of Claims in *Stilz v. United States*, *supra*, 269 U. S. 147, 70 L. Ed. 203, offered the following pronouncement:

“Infringement is a question of fact. The quoted finding is in the nature of special verdict of a jury. *United States v. Societe Anonyme des Anciens Etablissements*, 224 U. S. 309, 322, 330, 56 L. Ed. 778, 785, 788, 32 Sup. Ct. Rep. 479; *Brothers v. United States*, 250 U. S. 88, 93, 63 L. Ed. 859, 862, 39 Sup. Ct. Rep. 426. This Court accepts the findings of fact made by the Court of Claims and cannot review them. *Collier v. United States*, 173 U. S. 79, 80, 43 L. Ed. 621, 622, 19 Sup. Ct. Rep. 330. And even where a finding determines a mixed question of law and fact, it is conclusive unless the Court

is able to separate the question to see whether there is a mistake of law. *United States v. Omaha Tribe of Indians*, 253 U. S. 275, 281, 64 L. Ed. 901, 905, 40 Sup. Ct. Rep. 522; *Ross v. Day*, 232 U. S. 110, 116, 58 L. Ed. 528, 529, 34 Sup. Ct. Rep. 233; *Whitcomb v. White*, 214 U. S. 15, 16, 53 L. Ed. 889, 890, 29 Sup. Ct. Rep. 599; *Marquez v. Frisbie*, 101 U. S. 473, 476, 25 L. Ed. 800, 801.”

The Supreme Court in *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, *supra*, 310 U. S. 405, 52 L. Ed. 1122, 38 S. C. 748, held that the question of infringement was a question of fact upon which, both of the Courts below concurring, the findings would not be disturbed unless clearly in error.

In *Keyes et al. v. Grant et al.*, *supra*, 118 U. S. 25, 30 L. Ed. 57, the following language was employed in a case which related to improvements in lead smelting furnaces:

“The judgment entered on the verdict rendered in favor of the defendants, in pursuance of the direction of the Court, can be maintained only on the ground, either that the legal identity of the furnace described by Karsten with that covered by the plaintiffs’ patent was manifest as a matter of law, or that it was established as a matter of fact so conclusively by the evidence that a verdict the other way could not be supported, within the rule as stated in *Randall v. Baltimore & O. R. R. Co.*, 109 U. S. 478 (Bk. 27, L. Ed. 1003).

“Clearly it was not a matter of law that the specification of the plaintiffs’ patent, and the publication of

Karsten, taken in connection with the drawings intended in illustration, described the same thing. The differences were obvious in the arrangement of the parts, and the relation of the basin in one, and the fore hearth in the other, to the interior of the furnace, and the mode of connecting the one with the other for the purpose of drawing the metal from the furnace. So that it certainly was not a matter of mere judicial knowledge that these differences were either not material in any degree to the result or, if material at all, were only such as would not require the exercise of the faculty of invention but would be suggested by the skill of an experienced workman employed to produce the best result in the application of the well known arrangements of the furnace."

In *Thomson Spot Welder Company v. Ford Motor Company*, *supra*, 265 U. S. 446, 68 L. Ed. 1100, the Supreme Court affirmed the Sixth Circuit Court of Appeals in affirming a District Court of the Eastern District of Michigan in dismissing a bill filed to enjoin the alleged infringement of a patent. The following language of the Supreme Court is believed to be in point:

"* * * The question whether an improvement requires mere mechanical skill or the exercise of the faculty of invention is one of fact; and, in an action at law for infringement, is to be left to the determination of the jury. *Keyes v. Grant*, 118 U. S. 25, 36, 37, 30 L. Ed. 54, 57, 58, 6 Sup. Ct. Rep. 950; *Holmes v. Truman*, 14 C. C. A. 517, 29 U. S. App. 572, 67 Fed. 542, 543; *Hall v. Wiles* (C. C.), 2 Blatchf. 194,

Fed. Cas. No. 5,954; *Poppenhusen v. Falke* (C. C.), 5 Blatchf. 46, Fed. Cas. No. 11,280; *Shuter v. Davis* (C. C.), 16 Fed. 574, 566; *Blessing v. John Trageser Steam Copper Works* (C. C.), 34 Fed. 753, 754. Ordinarily, therefore, the case would call for the application of the well-settled rule that the concurrent findings of the lower courts on questions of fact will be accepted by this Court unless clear error is shown."

In *Corona Cord Tire Co. v. Dovan Chemical Corp.*, *supra*, 276 U. S. 375, 72 L. Ed. 616, the Supreme Court in pointing out an exception, applicable in the event of a conflict of decisions in lower Courts, to the rule emphasized herein stated the rule to which this exception related as follows:

"It is also claimed that because the Trial Court in this cause found, after hearing the witnesses, the weight to be with the petitioner and against Weiss, assignor of respondent, his conclusions of fact, except for manifest error, are to be treated as unassailable. *Adamson v. Gilliland*, 242 U. S. 350, 353, 61 L. Ed. 356, 357, 37 Sup. Ct. Rep. 169; *Davis v. Schwartz*, 155 U. S. 631, 39 L. Ed. 389, 15 Sup. Ct. Rep. 355; *Tilghman v. Proctor*, 125 U. S. 136, 149, 31 L. Ed. 664, 668, 8 Sup. Ct. Rep. 894, and *Mason v. United States*, 260 U. S. 545, 556, 67 L. Ed. 396, 400, 43 Sup. Ct. Rep. 200."

This Court of Appeals has long followed the rule and applied it rather recently in *Faulkner v. Gibbs*, 170 F. 2d 34, 79 U. S. P. Q. 158, with copious citations. The Supreme Court affirmed the case but had no occasion to refer specifically to this point. 94 L. Ed. Adv. Op. 30, 83 U. S. P. Q. 192.

II.

The Findings of the Court Below on the Issues of Infringement Are Fully Supported by the Evidence and Should Be Sustained.

A. Claim 1 of Patent No. 2,288,159 Is Clearly Not Infringed by the Defendants.

In an effort to distinguish Patent No. 2,288,159 over the prior art,¹ the plaintiff-appellant has considered it necessary to define the prior art to his own convenience by limiting it to potato handling mechanisms only. This is obviously a superlative absurdity. The patentee, F. J. Ernst, defined his machine as a “sacking device.” After extensive prosecution, the claims identify the mechanism as “a device for unloading belt conveyors of articles.” The mechanism is described as being adapted to receive “articles” which at one point are exemplified by reference to “potatoes, oranges, etc.” and at another point by reference to “walnuts, apples, and oranges.”

Ernst's recognition that his invention related to sacking devices generally, independent of the particular material to be sacked, was confirmed by the actions of the Patent Office in citing as references other sacking devices adapted to be utilized in connection with the deflecting of such articles from conveyor belts as “salt, sugar, flour, coffee, etc.” (*Bates*, Patent No. 643,102); “bottles” (*Norkewitz*, Patent No. 860,936); “wheat, corn, clay, coal, and other

¹Because the prior art is not very conveniently arranged in the book of exhibits, Transcript Volume II, nor well indexed, we have prepared and include in this brief as an appendix a list of the prior art patents and page references where copies are found.

loose material" (*Cunningham*, Patent No. 873,991); "packages and other articles" (*Nielsen*, Patent No. 869,725); "fruits and other products" (*Helenbolt*, Patent No. 1,338,729); "automobile tires" (*McBride*, Patent No. 1,504,894); "molds or other articles" (*Carpenter*, Patent No. 1,532,228); "fruits, vegetables and the like" (*De-Back*, Patent No. 1,961,478); "apples, peaches and like fruits" (*Vosler et al.*, Patent No. 2,026,200); and "diced fruits and/or vegetables" (*Erickson et al.*, Patent No. 2,043,739).

The appropriate prior art relates to belt conveyor systems generally and means for diverting materials carried thereby. The effort to limit the prior art to potatoes, in the face of the inventors' recognition of its broader scope, is as absurd as saying consideration of the prior art should be limited to structures previously used for potatoes harvested in Shafter or restricted to Irish potatoes because sweet potatoes are in another art. The plaintiff's expert witness, Harry Gearing [Tr. 264] considered all agricultural patents concerned with devices for unloading belt conveyors as relating to an art analogous to the subject invention.

As indicated by the extensive file wrapper references alluded to above and the additional references cited by the defendants at the trial, the Ernst conveyor belt unloading device was at most a very minor contribution to a crowded and well developed field of endeavor. The plaintiff's expert witness, Harry Gearing [Tr. 248] and the defendants' expert witness, J. Walker Glenn [Tr. 136 and 153] by his general testimony, agreed that both of the Ernst patents in suit related to a crowded art although Mr. Gearing qualified this opinion by indicating that the art was not crowded if limited to the potato field.

Diligent effort was made in behalf of F. J. Ernst to obtain broad protection on the Ernst sacking device but the Patent Office felt compelled to restrict the claims to narrow and specific terminology in view of the prior art. The Trial Court likewise felt it necessary to restrict interpretation of the claims to specific terminology in view of the art of reference and the additional patents cited by the defendants.

In the prosecution of Patent No. 2,288,159, Claim 1 was, prior to renumbering, Claim 11. Claim 11 was derived from Claims 8 and 9 originally submitted as Claims 1 and 2. The terminology of the resultant claim was deliberate and necessary to define novelty. Original Claims 1 and 2 related generally to elongated passageways having sack holders along the sides thereof and means in each passageway including a shearer for directing the articles into the open sacks held in the holders. These claims were rejected as presenting nothing patentable over the file jacket references of Nielsen, Helenbolt, De-Back or Erickson *et al.* In addition, Claim 2 was rejected in view of either Carpenter or Vosler *et al.* *Without argument*, the inventor cancelled Claims 1 and 2 and resubmitted them as new Claims 8 and 9. Claim 8 described the original structure contained in Claim 1 as including a frame having an endless belt, rods supported by the frame, one rod over each elongated edge of the belt, a shearer having rod engaging means at each end engaging said rods and adapted to slide thereon, the lower edge of the shearer being spaced from the belt and angularly positioned with respect to the elongated edge of the belt so that loose articles upon the belt would be shifted to one side and into one of the containers. Claim 9 contained the additional limitation that the shearer had a curved extension projected beyond the elongated edge of the

belt to direct articles from the belt to a particular container.

Claim 8 was rejected as fully met by Cunningham or McBride of record. Claim 9 was rejected on Cunningham or McBride in view of Norkewitz of record. *Without argument* the applicant cancelled Claims 8 and 9, re-writing the same as new Claim 11 which was essentially Claim 8 with the additional significant limitation of the combination of a "loose sleeve on each bar having attached coupling means to hold a plate," and "a plate having a portion of its end in the coupling means." In the "Remarks" which accompanied Claim 11 when it was submitted, the applicant through his attorney emphasized the distinction over the prior art of "sleeves" mounted loosely upon the bars. Upon the limiting of the subject matter covered by the series of claims discussed by the inclusion of the "loose sleeve on each bar" and that the plate have "a portion of its ends" in the coupling means, the claim was allowed by the Patent Office and was subsequently re-numbered Claim 1 and became the only claim in Patent No. 2,288,159 which the Defendants are alleged to infringe.

Certainly, the precise points of novelty, if novelty is present in the structure defined by Claim 1, must of necessity reside in the precise combination set forth including "*a loose sleeve on each bar having attached coupling means to hold a plate,*" and "*a plate having a portion of its ends in the coupling means.*" **This precise structure is not even alleged to be found in any of the defendants' apparatus.** In fact, the plaintiff's testimony [Tr. 69] and the testimony of the plaintiff's witness, Harry Gearing [Tr. 296], as well as the testimony of the defendants' witness, J. Walker Glenn, conclusively establishes that the

defendants have not employed the “loose sleeves” in the structure claimed, nor a plate “having a portion of its ends in the coupling means.” Visual reference to the photographs of the defendants’ apparatus readily confirms this.

Although the validity of Patent No. 2,288,159 is not attacked by any cross-appeal this Court will no doubt consider the interpretation of the claim prerequisite to validity of the patent in determining the question of infringement. The plaintiff-appellant emphasized the significance of the sleeves and distinguished the sleeves over the rollers and other mounting structures of the prior art in the testimony of Harry Gearing. [Tr. 230 and 252.] At transcript, page 291, this plaintiff’s witness further agreed that the novelty of the Ernst invention, if any, resided in the simplicity of the mechanism achieved by the specific design of the sleeves 54 and their attachment to the shearer plate 52. Mr. Gearing further emphasized [Tr. 256 and 291] that the Ernst sleeves were distinguishable as a carrying means for a shearer plate over wheels or trolley pulleys mounted on a rod or track, because of their simplicity.

Prerequisite to the validity of Patent No. 2,288,159 was the establishment that the sleeves and shearer mounting of this Ernst patent were not equivalent to the following antecedents in the prior art:

a. The trolley wheels or rollers 10 mounted on the track 9 of the unloading mechanism of *Cunningham* shown in Patent No. 873,991. [Tr. 424.]

b. The shear plate or deflector 28 slidably mounted on the tight guy wires 30 of Patent No. 1,338,729 to *Helenbolt*. [Tr. 431.]

c. The guide arm 36 of the *True* conveyor system shown in Patent No. 1,369,502 [Tr. 403] adjustably positioned in brackets 37 arranged at selected positions longitudinally of an endless conveyor.

d. The plow or shearer 30 mounted for adjustable positioning longitudinally of an endless conveyor 24 by a frame 27 mounted for slidable movement on a pair of spaced metal strips 25 incorporated in the *Paisley* apparatus of Patent No. 1,818,427. [Tr. 413.]

e. The scooter blocks 46, 47, 48, and 49 of *Vosler et al.* of Patent No. 2,026,200 [Tr. 479] supported at one side by a roller 51 and at the opposite side by a plate or track 44 on which a connecting member 45 is guidedly rested. This structure is clearly evident in Fig. 3 and moves longitudinally of an endless conveyor belt 21.

Having established that the rollers, slides, and the like of the prior art patents are not equivalent to the sleeves of the Ernst structure, the plaintiff-appellant performs the legal contortion of now urging that the trolley wheels and supporting structure of the applicant's apparatus is a mechanical equivalent. The law has not been uncertain where such equivocation is necessary to urge infringement. It has been clearly established that a range of equivalents will not be allowed which would give to a claim an enlarged scope that was expressly denied to it in the Patent Office.

Smith v. Magic City Kennel Club, Inc., 282 U. S. 784, 789, 790, 75 L. Ed. 707 (1931);

I. T. S. Rubber Co. v. Essex Rubber Co., 272 U. S. 429, 71 L. Ed. 335;

- Weber Elec. Co. v. E. H. Freeman Elec. Co.*, 256 U. S. 668, 677, 65 L. Ed. 1162;
E. Van Noorden Co. v. Cheney Co., 75 F. 2d 298, 302, C. C. A. 1 (1934);
Kaumagraph Co. v. Superior Trade Mark Mfg. Co., 72 F. 2d 417, 420, C. C. A. 2 (1934);
Knick v. Bowes "Seal Fast" Corp., 25 F. 2d 442, 446, C. C. A. 8 (1928);
Wood v. Boylan, 19 F. 2d 48, C. C. A. 8 (1927);
Dry Hand Mop Co. v. Squeeze-Ezy Mop Co., 17 F. 2d 465, C. C. A. 5 (1927);
Hennebique Const. Co. v. Urban Const. Co., 182 Fed. 496, C. C. A. 8 (1910);
Brill v. St. Louis Car Co., 90 Fed. 666, C. C. A. 8 (1898).

This Court in *International Harvester Co. v. Killefer Mfg. Co.*, 67 F. 2d 54, held:

"The range of equivalents to which the patent is entitled depends upon the scope of the invention. The range of equivalents to be allowed cannot be extended to cover means which have clear antecedents in the prior patented art."

In *Magnavox Co. v. Hart & Reno et al.*, 73 F. 2d 435, this Court stated in connection with facts similar to the present action:

"Assuming, then but not deciding, that the patents in suit are valid, the invention, if any, therein disclosed is of so limited a nature as to require a strict construction of the various claims relied upon by appellants. We do not believe that the patents, even if valid, are of 'pioneer' or 'primary character' . . . Such a situation calls for a strict construction of the patents."

Further, in *Miller v. Eagle Mfg. Co.*, 151 U. S. 186, it is stated:

“The range of equivalents depends upon the extent and nature of the invention.”

Further, rulings of this Court consistent with this sound doctrine are found in:

Thomas Day Co. v. Doole Laboratories, 42 F. 2d 6;

Eaid v. Twohy Bros. Co., 230 Fed. 444;

Wilson & Willard Mfg. Co. v. Union Tool Co., 249 Fed. 729;

Pacific States Electric Co. v. Wright, 277 Fed. 756;

Overlin v. Dallas Machine & Locomotive Works, 297 Fed. 7.

In *Carlson Hoist and Machine Co., Inc. v. Builders Equipment Corporation*, 96 F. 2d 145, the Second Circuit Court of Appeals refused to employ the doctrine of equivalents to establish infringement where the patented disclosure of another party would then be an anticipation.

In *Mason Corporation et al. v. Halliburton et al.*, 118 F. 2d 729, the Tenth Circuit Court of Appeals stated:

“The range of equivalents depends upon the degree of invention . . . The patent in suit marked only a slight advance or improvement over the prior art and its range of equivalents is narrow. Its range of equivalents cannot be extended to cover means which have clear antecedents in the prior art.”

In *Lunati v. Barrett*, 104 F. 2d 313, involving facts similar to those of the instant case, the Sixth Circuit Court of Appeals stated:

“The claims in suit must be narrowly construed within the principle so often applied in this Court that where claims define an element in terms of form, location, or function, thereby creating an express limitation, where that limitation pertains to the inventive step and imports a substantial function which the patentee considered of importance, the Court cannot be permitted to say that other forms which the inventor thus declared not equivalent are so to be treated.”

Still further, the United States Supreme Court in *MacKay Radio & Telegraph Co., Inc. v. Radio Corporation of America*, 306 U. S. 86, held that a patentee who avoided prior art by defining an angle for directive radio antennae with mathematical precision, could not discard that precision to establish infringement by structures wherein the angles varied slightly from angles derived by the use of the patented formula. This case is consistent with the view expressed by Chief Justice Taft in *Eibel Process Co. v. Paper Co.*, 261 U. S. 45, as follows:

“If what he (the inventor) has done works only a slight step forward, and that which he says is discovery is on the border line between mere mechanical change and real invention, then his patent, if sustained, will be given a narrow scope, and infringement will be found only in approximate copies of the new device.”

As pointed out by the Trial Court, the validity of Claim 1 of Patent No. 2,288,159 and its infringement by the apparatus of the defendants are absolutely incompatible.

B. Claim 1 of Reissue Patent No. Re. 22,740 Is Clearly Not Infringed by the Defendants.

Claim 1 of the above identified reissue patent defines the subject invention as “a device for shaking containers and the like to settle the contents thereof.” Obviously, the art to which this patent relates includes container shaking and jiggling devices generally and is not limited to the shaking or jiggling of sacks for potatoes alone, as the plaintiff-appellant has deemed necessary to urge in his Opening Brief. Although the invention is described by the applicant in his patent as being “especially useful in machine sacking of potatoes and other vegetables, and particularly those vegetables and/or fruits which are generally shipped in long sacks,” such particular usefulness does not even limit the device, nor the prior art, to fruits or vegetables.

The Patent Office appropriately interpreted the Ernst “sack jigger” as relating to shaking devices generally and in no way limited to a particular article to be sacked or container. For example, the *Nielsen* file wrapper reference, Patent No. 869,725, refers to “packages and other articles”; *Kceran*, Patent No. 893,516, to “grain, granular or loose material”; *Broussard*, Patent No. 1,014,444, to “sugar, corn, rice”; *Stehlin*, Patent No. 1,191,243, to “grain and various materials”; *Cowley*, Patent No. 1,225,586, to “a series of articles”; *Sargent*, Patent No. 1,352,225, to a jiggled washing machine; *Williams*, Patent No. 1,640,103, to “grain”; *Shaler*, Patent No. 1,924,202, to “mill feeds or similar products”; *Nicolas*, Patent No. 2,119,174, to “coffee, sugar, cocoa, flour, rolled oats, cereals”; *Anderson*, Patent No. 2,234,069, to “flour”; *Belcher et al.*, Patent No. 2,234,953, to “sugar, cocoa, coffee, flour, and various other comminuted materials.”

The extent of the prior art of reference and the additional patents cited by the defendant-appellee herein indicate that structures for shaking containers to settle the contents therein constitute an old and crowded art. The defendants-appellees' expert witness J. Walker Glenn [Tr. 152 and 153] and the plaintiff-appellant's expert witness, Harry Gearing [Tr. 248, 261 and 262], concurred in this, although Mr. Gearing qualified his analysis of the field as being crowded by indicating that he did not believe it was crowded if the art were limited to the potato field. As previously discussed, no such self-service in limiting the art to which an invention relates is permissible in instances of this kind.

Certainly, if the Ernst sack jiggler made any contribution to the crowded and thoroughly developed art of shaking devices to which it relates, such contribution is so minor as to be almost undetectable. Even though the plaintiff-appellant's expert witness Gearing had never seen any potato sacking machine, he did not believe that the development of the sack jigger of the Ernst patent Re. 22,740 would have presented any difficult or insurmountable problem. [Tr. 268 and 270.] Mr. Gearing considered the Ernst "Sack Jiggler" to contain *nothing new* but rather to be the adaptation of old principles to a new art, the new art being defined as that of sacking potatoes. [Tr. 261 and 286.]

During the prosecution of the original patent of Re. 22,740, the prosecution of the reissue application, and the appeal, diligent effort was made to obtain broad protection, but the Patent Office and the Board of Appeals believed themselves obligated to limit the claims to the specific language employed because of the prior art. The claim in suit was not broadened one iota by the reissue

or appeal procedures. The first patent application relating to the Sack Jigger filed by Mr. Ernst contained fourteen claims, all of which were rejected and subsequently cancelled by the applicant *without argument*. In the first amendment filed by the applicant, new claims 15, 16, 17, 18, 19 and 20 were offered, all of which were rejected on the prior art but the suggestion was made that Claim 20, based upon rejected Claim 18, would be allowable if rewritten to include the subject-matter of Claim 18.

Claim 21, the first claim to be allowed, and the claim which subsequently became Claim 1 of the reissue Patent No. 22,740 on which the alleged infringement is based, was submitted incorporating the language of Claims 18 and 20. It will be noted that Claim 18 as originally submitted, rejected, and cancelled was a narrow claim including a platform for supporting a plurality of containers having vibratory means connected to the platform for shaking it. This was anticipated by the prior art and such anticipation recognized by cancellation thereof by the applicant. Claim 21 was distinguished from Claim 18 in the provision that said platform included an elongated surface with container stations from the ends thereof to a *central open locus* and that vibratory means be provided consisting of a *pitman* adjacent to the platform, said vibratory means *having its connection with the platform at this central open locus*.

Although the applicant mentioned in his specification that the vibratory means need not be connected to the central open locus and endeavored to avoid limiting his claims in this particular, it is noted that without such restrictions, no claims were allowable on the structure defined by Claim 1 and that file wrapper estoppel operates to limit the protection to the specific structure defined in

Claim 21 which resulted in Claim 1 of Reissue Patent No. 22,740.

If Claim 1 relates to any novel structure whatsoever, such novelty must of necessity reside in the combination of an elongated platform having a "*central open locus*" and a vibratory means including a "*pitman*" "having its connection with the platform *at its central locus*."

As Mr. Gearing testified, the prior art showed pitmans connected both centrally [Tr. 282] and to the end [Tr. 283] of movable platforms adapted to receive material to be jiggled. It was Mr. Gearing's opinion that a man skilled in the art could readily modify the *Stehlin* device [Tr. 268 and 270], the *Belcher* device [Tr. 280], and the *Naeher* device [Tr. 279], to obtain the precise structure of the Ernst sack juggler without any unreasonable trouble. For example, this plaintiff-appellant's witness could only distinguish the Ernst device over the Naeher structure, not cited by the Patent Office [Pat. No. 1,719,124; Tr. 377], in that he did not consider the platform 12 although adapted to hold a pair of sacks, to be "elongated" and in that he believed the Naeher device to be for filling sacks of grain, not potatoes. [Tr. 271 *et seq.*] He acknowledged the central open locus in the platform and the connection of the vibrating means to the platform at said central open locus. [Tr. 275.] In spite of the demonstrated operation of the Naeher bag filling machine of Fig. 5, he was inclined to believe that the structure was inoperable inasmuch as the crank shafts 16 and 17 were shown in straight line form, as viewed in Fig. 1.

Mr. J. Walker Glenn explained that the Naeher device was operable. [Tr. 148.] The crank shafts 16 and 17 are in reality offset crank shafts but are viewed in Fig. 1 on a line of sight making them appear as straight shafts.

The combination of Claim 1 including an elongated platform having a “central open locus” and having vibratory means connected to the platform at its “central locus” is not found in any of the defendants’ apparatus.

Prerequisite to the establishment of validity of the Patent No. Re. 22,740 was the establishment that the structure defined is not equivalent to that set forth in the patents to *Nacher*, *Bradbury*, *Fuerste*, *Broussard*, *Stehlin*, *Sargent*, *Erickson et al.*, and the other patents cited in connection with the sack jiggler of Ernst.

For example, Claim 1 to be valid must be interpreted so narrowly as not to be equivalent to the structure of *Nacher* [Tr. 377] which includes a framework 11, a platform 12 for supporting a plurality of containers, vibratory means 16 and 17 connected to the platform for shaking it and the containers supported thereby, said platform including an elongated surface (see 12 and 43) with container stations from the ends thereof to a central open locus, said vibratory means 16 and 17 having connection with the platform at its central locus. Further, to be valid, said Claim 1 must be interpreted as not the mechanical equivalent of the chaffing screen 72 of the *Bradbury* Patent No. 26,988 [Tr. 356] which is suspended on links 71 identical to the structure employed by Ernst and covered by Claim 1 and driven by a pitman 100-101 connected to the end of the platform.

The uncontroverted testimony of J. Walker Glenn [Tr. 118 *et seq.*] establishes that such a structure was employed by him in the handling of potatoes and onions in 1927 or 1928 or thereabouts and that sometimes the screen was covered, in which event the screen became a platform.

None of the defendants' apparatus employs a platform having a central open locus and connection of the vibratory means to the platform at the central open locus. Still further, if Claim 1 of Re. 22,740 is interpreted as requested by the plaintiff-appellant, it reads on the structure of the British patent to Belcher No. 397,679 of August 1, 1933. [Tr. 383.] This patent alone is sufficient to restrict interpretation of Claim 1 to the precise terminology employed. Certainly, the patent to Belcher considered with the other patents to which reference has been made, precludes any other interpretation.

Conclusion.

In order to plead infringement of Claim 1 of Patent No. 2,288,159 and of Claim 1 of Reissue Patent No. Re. 22,740, the plaintiff-appellant has had to urge a range of equivalents in construing the claims which extends into the prior art. Enlargement of the claims in this manner cannot be permitted in view of *International Harvester v. Killifer Manufacturing Co.*, 67 F. 2d 54, and the other cases previously cited in this connection.

The judgment of the District Court should be affirmed.

April 14, 1950.

Respectfully submitted,

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APPENDIX.

List of Prior Art Patents.

*Denotes a file wrapper reference in Ernst Patent 2,288,159

**Denotes a file wrapper reference in Ernst Patent Re. 22,740

#Denotes a file wrapper reference in Ernst Patent 2,347,474

Others were not cited by the Patent Office

<u>PATENT No.</u>	<u>NAME</u>	<u>TITLE</u>	<u>Copy in Vol. II of Tr., Page</u>
420,049	Furerste	Working Body Churn	347
435,681	Buschmann	Device for Oscillating Photographers' Developing Pans	352
* 643,102	Bates	Sacking and Weighing Machine	487
805,625	Blank	Cracker Conveyor and Distributor	398
826,988	Bradbury	Grain Separator	355
* 860,936	Norkewitz	Bottle Carrier for Bottling Establishments	444
** * 869,725	Nielsen	Package Feeding Machine	449
* 873,991	Cunningham	Unloading Mechanism	423
#** 893,516	Keeran	Sack Filling Apparatus	499
1,014,444	Broussard	Bag Filling Machine	367
#**1,025,781	Broussard	Bag Filling Machine	503
#**1,191,243	Stehlin	Bag Filling Machine	336
**1,225,586	Cowley	Selective Discharge Conveyor	459
*1,338,729	Helenbolt	Sorting Apparatus	431
#**1,352,225	Sargent	Washing Machine	556
1,369,502	True	Conveyor System	402

*Denotes a file wrapper reference in Ernst Patent 2,288,159

**Denotes a file wrapper reference in Ernst Patent Re. 22,740

#Denotes a file wrapper reference in Ernst Patent 2,347,474

Others were not cited by the Patent Office

<u>PATENT No.</u>	<u>NAME</u>	<u>TITLE</u>	Copy in Vol. II of Tr., <u>Page</u>
1,465,609	Macbeth	Conveyor for Vulcanizing Presses	408
*1,504,894	McBride	Mold Loader	467
*1,532,228	Carpenter	Deflecting Device for Con- veyor System	474
1,616,016	Wertenbruch	Bag Filling Machine	418
#**1,640,103	Williams	Sack Jigger	511
1,719,124	Naeher	Bag Filling Machine	376
1,818,427	Paisley	Apparatus for Loading Mine Cars	412
#**1,924,202	Shaler	Sack Packer	515
*1,961,478	DeBack	Sizing Apparatus	548
*2,026,200	Vosler, <i>et al.</i>	Material Handling System	478
*2,043,739	Erickson, <i>et al.</i>	Method and Apparatus for Proportioning and Mixing Fruit	435
#**2,119,174	Nicolas	Filled Bag Settling and Shap- ing Method and Apparatus	519
**2,288,159	Ernst	Sacking Device	323
#**2,234,069	Anderson	Machine for Settling and Compacting Flour in Bag	530
#**2,234,953	Belcher, <i>et al.</i>	Machine for Compacting Ma- terial in Containers	540
397,679 (British)	Belcher		383
69,746 (German)	von den Wyngaert		388
512,780 (German)	Steimel		392